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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/918,968	07/30/2001	Hatem Oueslati	PALM-3686	2575

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WAGNER, MURABITO & HAO LLP
Third Floor
Two North Market Street
San Jose, CA 95113

EXAMINER

EISEN, ALEXANDER

ART UNIT	PAPER NUMBER
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2674

4

DATE MAILED: 03/04/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/918,968

Applicant(s)

OUESLATI ET AL.

Examiner

Alexander Eisen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 January 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2 and 4-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2 and 4-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Objections

1. The objection to claim 5 is withdrawn necessitated by amendment (claim 3, duplicate of claim 5, has been cancelled).

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1-2, 4-8 and 12-13 are rejected under 35 U.S.C. 102(e) as being anticipated by Morgenthaler, US 6,310,609.

With respect to claims 1 and 6 Morgenthaler discloses a user interface for portable electronic device including a keyboard having illuminated keys wherein a plurality of functions associated with each of the plurality of keys (note the indicia on the keys) for providing a user with guide functions (see abstract, FIGS. 1, 4 and 5; col. 5, line 42 – col. 6, line 60). In response to execution of function (a key required to be pressed before the next key) the next key will be illuminated.

As to claim 2, Morgenthaler's buttons have contoured region in shape of symbols, which functions they represent.

As to claim 4, the illuminatable keys are controlled by a microcontroller executing a program (see flowchart in FIG. 4).

As to claims 5 and 7-8, the button can have two different colors illuminating sources to convey to the user another function (col. 5, lines 36-42; col. 9, lines 10-15).

As to claims 12-13, Morgenthaler further teaches, that in order to provide the user with additional information, an indexing key (up and down key 342) is equipped with two light sources, which are only illuminated when the user can scroll up or down (see col. 6, line 60 – col. 7, line 3).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 9-10 and 14-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Detlef, US 6,178,403 in view of Chou, US 6,339,374 and further in view of Morgenthaler.

With respect to claims 9-10 and 14-28 Detlef discloses a palmtop computer system (FIG. 1) provided with various hard buttons for interfacing with such application programs as a date book application (button 22), address book application (button 32), to-do application (button 38) and memo application (button 34).

Pressing the hard buttons starts the corresponding application and a user receives or is notified of different conditions and alerts related to the applications through the audio signals or by displaying them on the LCD display.

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Detlef does not teach that those conditions or events are conveyed to the user by means of illuminating related buttons.

Chou teaches a receiving indication apparatus for e-mail located in a computer keyboard, wherein when the e-mail is arrived to the computer, a user is alerted by activating a light emitting diode (col. 2, lines 45-55). Thus, Chou teaches that the event occurred in a computer system can be conveyed to the user by means of light indicator situated on the computer keyboard.

None of the above teaches or suggests that the alert can be conveyed to the applicant by illuminating a contoured region formed on the button in a shape of a symbol that represents the corresponding application.

Morgenthaler discloses a user interface for portable electronic device including a keyboard having illuminated keys for providing a user with guide functions, wherein the buttons have contoured regions in shape of symbols, which functions they represent.

It would have been obvious to one of ordinary skill in the art at the time when the invention was made that in view of Morgenthaler various events associated with the applications taught by Detlef can be conveyed to the user by light indication alert messages as taught by Chou by using the lighted buttons arrangement taught by Morgenthaler, because the latter lends itself conveniently to such usage without necessity to provide additional light sources, and therefore allows the optimal usage of the limited space of palm top computing system.

Response to Arguments

6. Applicant's arguments filed on 20 January 2004 have been fully considered but they are not persuasive.

Applicant argues with respect to claim 1 that the reference does not teach or suggest “a particular hard button”, which is selectively illuminated “to convey information to a user in response to the execution of a particular function associated with this particular button”. Examiner respectfully disagrees. Morgenthaler teaches illuminating of a hard button (“next key”) in response to execution a function associated with the button, the function of previously executed button causes the hard button to be highlighted, which means that the executed function is associated with the “next button”. Applicant further argues that does not teach illuminating a particular button to convey information to a user in response to the execution of a particular button. Examiner respectfully disagrees. Morgenthaler teaches that in response to pressing of a key only “next keys” will be illuminated, thus conveying information to a user what functions will be available and what key is to be pressed next in sequence for a particular operation (col. 6, lines 1-5).

With respect to claim 6 applicant argues that reference of record does not teach “providing a hard button that is operable to perform a primary function, said hard button having a contoured region formed therein that is contoured in the shape of the symbol that represents said primary function”. Examiner respectfully disagrees. Morgenthaler teaches hard buttons that have contoured regions formed on the buttons (for example buttons 136, 138 and 140), contoured regions (or indicia) representing the primary function of the buttons (“soft” 138 or indexing key 136).

Applicant argues with respect to claim 19 that Detlef does not teach hard buttons that have contoured regions, does not teach or suggest limitation “providing a first hard button that is operable to initiate operation of a date book application, said first hard button having a contoured

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region formed therein that is contoured in the shape of a symbol that represent said date book". Examiner respectfully disagrees. Detlef teaches a date book button 22 (in FIG. 1), and it would be obvious that the date book button would have some indicia representing function of the date book, the illuminated indicia taught by Morgenthaler, for example.

All other applicant's arguments pretty much reiterate the arguments discussed above and examiner's rationale has been conveyed to the applicant.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alexander Eisen whose telephone number is (703) 306-2988. The examiner can normally be reached on M-F (8:30-4:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard A. Hjerpe can be reached on (703) 305-4709.

Any response to this action should be **mailed to:**

Commissioner of Patents and Trademarks

Washington, D.C. 20231

or **faxed to:**

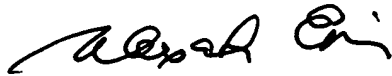
(703) 872-9306 (for Technology Center 2600 only).

Hand-delivered responses should be **brought to:** Crystal Park Two, 2121 Crystal Drive, Arlington, Virginia, Sixth Floor Receptionist.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be **directed to:** Technology Center 2600 Customer Service Office, whose telephone number is (703) 306-0377.

A handwritten signature in black ink, appearing to read "Alex Eisen".

Alexander Eisen
March 3, 2004